

APPLICANT(S): NAPADENSKY, Eduardo et al.  
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### REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested. Applicant would like to thank the Examiner for identifying issues in the application.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### Status of Claims

Claims 80, 91 – 93, 95 – 100 and 125 remain pending in the application. Claims 80, 82, 87, 89 – 93, 95 – 102, 104, 105, 125 and 126 have been rejected. Claims 80, 91, 93, 97, 98 and 125 have been amended. No new matter has been added.

Claims 82, 87, 89 – 90, 101 – 102, 104, 105 and 126 were cancelled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

### Allowable Subject Matter

In the Office Action, the Examiner indicated that claims 93 and 126 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 and to include all the limitations of the base claims and any intervening claims. Applicant has amended independent claim 80 to overcome the 35 U.S.C. 112 rejections as detailed below and to include the limitations of claim 126. Applicant has amended claim 93 to include all the limitations of the base claim and to overcome the rejection(s) under 35 U.S.C. 112. Accordingly, amended claims 80 and 93 are allowable.

### CLAIM REJECTIONS

#### 35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected claims 80, 82, 87, 89 – 93, 95 – 102, 104, 105, 125 and 126 under 35 U.S.C. § 112, first and second paragraphs.

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Claims 80 and 93 have been amended to claim a method for the preparation of a multi-phase composite material. As suggested by the Examiner the elements "generating data from a CAD system and a system controller", "each composition being dispensed from a different dispenser via ink jet nozzles", "adjusting the output from said inkjet nozzles according to the data generated to control the properties of different combinations of said compositions" and "to provide two or more different phases or regions of the multi-phase composite material that are structurally different, chemically different or have different properties" were specifically claimed in claim 80.

Furthermore the term "type" was deleted from claim 80

Claims 82, 89 - 90, 101 -102, 104 and 105 were cancelled without prejudice or disclaimer and therefore the rejections of these claims are now moot.

Accordingly, Applicant respectfully asserts that these amendments render claim 93, claim 80 and its dependent claims 82, 91 - 92, 95 - 100 and 125 and claim 93 proper under 35 U.S.C §112 and requests that the rejections be withdrawn.

### **35 U.S.C. § 102 Rejections**

Claims 80, 82, 89 - 92, 95 - 99, 101 - 102, 104 and 125 are rejected under 35 U.S.C. § 102(b), as being anticipated by Helinski (5,136,515).

Claims 80, 82, 89 - 92, 95 - 99, 101 - 102, 104 and 125 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamane et al. (5,059,266).

Claims 80, 82, 89 - 92, 95 - 99, 101 - 102, 104 and 125 are rejected under 35 U.S.C. 102(b) as being anticipated by Napadensky in US 2002/0016386, published 02/07/2002.

Claims 82, 89 - 90, 101 -102, 104 and 105 were cancelled without prejudice or disclaimer and therefore the rejections of these claims are now moot.

Independent claim 80 has been amended to include the limitation of claim 126 indicated by the Examiner as containing allowable subject matter.

Claim 93 indicated by the Examiner as containing allowable subject matter has been amended to be in independent form including all the limitation of the base claim.

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The references cited above does not teach, disclose or fairly suggest, alone or in combination, and the Examiner does not contend that the references teach or suggest amended claims 80 and 93.

In view of the above, it is respectfully submitted that independent claims 80 and 93 are allowable.

Claims 82, 91 - 92, 95 - 100 and 125 depend directly or indirectly from claim 80, and thereby include all the limitations of claim 80 as well as additional distinguishing elements. Therefore, claims 82, 91 - 92, 95 - 100 and 125 are patentable for at least the reasons discussed above with regard to claim 80. Accordingly, Applicant requests that the rejections of claims 80, 82, 89 - 92, 95 - 99, 101 - 102, 104 and 125 be withdrawn.

#### **Double Patenting Rejections**

Claims 80, 82, 87, 89 - 93, 95 - 102, 104, 105, 125 and 126 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. US 6,569,373 (Napadensky).

Applicant hereby provides a terminal disclaimer and requests that the rejection be withdrawn.

#### **CONCLUSION**

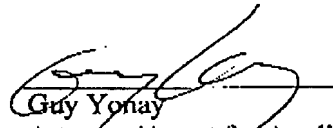
In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

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